

REMARKS

Claims 1-20 remain in this application. Claims 1, 9, 10, and 18 have been amended. Claims 19 and 20 have been added. The Applicant respectfully requests reconsideration and review of the application in view of the amendments and the followings remarks.

Initially, the Applicant would like to express its gratitude toward the Examiner and the Examiner's supervisor for taking the time to discuss the present application by telephone on June 7, 2004 prior to making this submission. The amendments herein reflect the subject matter discussed by telephone with the Examiner and the Examiner's supervisor and are believed to place the claims in condition for allowance.

Claims 1-18 are rejected in the current Office Action under 35 U.S.C. §§ 102(e) and 103(a) as unpatentable over Torchalski (U.S. Patent Application Publ. No. 2002/0074408). These rejections are respectfully traversed.

The present invention is directed to a system and method that inserts printable formatting commands into an electronic document, that results in physical formatting commands present in a printed version of the document. The physical formatting commands pre-define for a scanner various format attributes of the printed document (e.g., fonts, font sizes, alignment tags, tabs, margins, table definitions, and/or picture definitions) to improve the understanding of the printed document by the scanner. The printed document is then scanned by the scanner that interprets the physical formatting commands, and therefore, the physical document is transformed into an electronic version by the scanner in accordance with the interpreted formatting commands.

Torchalski, by contrast, is directed to a scanning software program that recognizes barcodes as barcodes (and not just as a graphic). That is, the scanning software in Torchalski separates materials on scanned documents into three categories with text categorized as text, graphics categorized as graphics, and barcodes categorized as barcodes. There is no indication or suggestion in Torchalski that the

recognized barcodes contain information to improve the understanding of a scanner to scan a physical document or that a scanner transforms a physical document into an electronic (or original) document in accordance with formatting commands that are physically inserted into the physical document as is disclosed by the present application and defined in the present claims.

In addition, Torchalski discloses that its scanning software can be used with special printer command codes. Torchalski specifically discloses that these command codes "do not physically print." See page 1, paragraph 4. These "non-printing" software command codes (i.e., in software only) are used only to control a printer used with Torchalski's scanning software. See page 2, paragraph 28. Thus, the present invention's formatting commands, which are physically placed on the printed document to improve the understanding of the document that the scanner is scanning, is functionally and structurally different from Torchalski's software printer command codes that "do not physically print."

Accordingly, any superficial similarities between the present invention and Torchalski are immaterial and Torchalski does not disclose or teach all features of the present invention's device manager.

Specifically, with regard to amended independent Claim 1, the Applicant respectfully submits that Torchalski fails to disclose or suggest a method for converting a physical document into an electronic document comprising:

**inserting one or more formatting commands into an initial electronic document;**

**converting said initial electronic document into a physical document with said inserted formatting commands;**

**scanning said physical document using a scanner to produce a second electronic document wherein said scanner is configured to interpret said formatting commands and to transform said physical document into said second electronic document in accordance with said formatting commands.**

(Emphasis in bold added).

Amended independent Claim 10 should also be allowable because Torchalski does not disclose or suggest a computer program product comprising:

a computer usable medium having computer readable program code embodied therein configured to convert a physical document into an electronic document, said computer program product comprising:

computer readable code configured to cause a computer to **insert one or more formatting commands into an initial electronic document;**

computer readable code configured to cause a computer to **convert said initial electronic document into a physical document which includes said inserted formatting commands;**

computer readable code configured to cause a computer to scan said physical document using a scanner to produce a second electronic document wherein said scanner is configured to interpret said formatting commands and **wherein said interpreted formatting commands are used to transform said physical document into said second electronic document.**

(Emphasis in bold added).

Therefore, because Torchalski fails to disclose or suggest the above limitations of independent Claims 1 and 10, the rejections of these claims, as well as Claims 2-8, and 11-18, which depend from Claims 1 and 10, respectively, should be withdrawn.

In addition, dependent Claims 9 and 18 have been amended to further clarify the claims (e.g., to further clarify that the bar codes placed into the physical document are viewable or physical representations of said formatting commands). The limitations in these amended dependent claims are not disclosed or suggested in Torchalski.

Moreover, for example, Claims 2 and 11 should be allowable for the additional reason that Torchalski does not disclose or suggest "wherein said formatting commands are fonts."

Claims 2 and 12 are each independently allowable because they each recite the limitation of "wherein said formatting commands are font sizes." Similarly, Torchalski does not disclose or suggest "wherein said formatting commands are table definitions" as is recited in Claims 7 and 16 or "wherein said formatting commands are picture definitions" as is recited in Claims 8 and 17.

New Claims 19-20 have been added and depend (directly or indirectly) on Claim 1. It is respectfully submitted that the limitations in these new claims are neither disclosed in nor suggested by the cited reference.

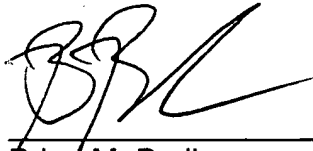
Lastly, if rejections based on Torchalski (which only has a provisional filing date that is one month prior the actual filing date of the present application) are still maintained by the Examiner, the Applicant respectfully reserves the right to present additional arguments and/or investigate, and possibly overcome this cited reference, by affidavits or declarations under 37 C.F.R. §§ 1.131 or 1.132, by continuation application, or by any other means.

In view of the foregoing, the Applicant respectfully submits that Claims 1-20 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. If it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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While the Applicant believes that no fees are due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in the fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'B. Berliner', written over a horizontal line.

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